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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,374

07/14/2005

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EXAMINER

TRUONG, THANH K

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

01/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/542,374

Applicant(s)

AKATSUKA ET AL.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on December 5, 2007.
2. Examiner's note: it should be pointed out that the claims (1-4 and 7-9) as recited contain mostly intended use recitations. The intended use recitation describes what the "single pad that has a through hole" does, and it does not provide any structure limitation of the claimed invention.

In other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.**

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Koike (US 2002/0189970).

Koike discloses an apparatus comprising: a packaging carton (2); a shock absorbing material (10, 20, 30) for packaging, the material comprising a hole for deaeration (figures 1 and 2 show holes are formed on all sides of the shock absorbing

material) which is formed so as to penetrate between a first surface (such as the bottom surface or the outside surfaces of the shock absorbing material) thereof which is brought into contact with an inner surface of a packaging carton (2) when the shock absorbing material is placed in the packaging carton (figure 1), and a second surface (such as the top surface or the inside surfaces of the shock absorbing material) thereof on which a target to be packed (50) is placed via a thin film member (6) for packaging which is thinly formed.

Koike further discloses:

Regarding claim 2, the shock absorbing material has a deaerating-duct insertion opening which is formed so as to penetrate through the first and second surfaces, and into which a deaerating-duct can be inserted (it is construed that the shock absorbing material has grooves and recesses that openings are formed so as to penetrate between the first and second surfaces, and a deaerating-duct is certainly capable of being inserted into these openings all around the shock absorbing material. Furthermore, the functional recitations of claim 2 only require that the apparatus is capable of performing the functioning as recited).

Regarding claim 3, the material includes grooves for deaeration which are formed in either or both of the first and second surfaces, and which provide communication between the deaerating-duct insertion opening and the hole for deaeration (see paragraph regarding claim 2 above).

Regarding claim 4, the hole for deaeration is formed on a side of a dented portion for product placement formed in the second surface (as mentioned above, holes are

formed all around the shock absorbing material for deaeration, and figures 4, 6 and 8 show that the product (50) is placed in the dented portion in the second surface).

Regarding claim 7, at least one dented portion in the second surface, the dented portion for placement of the product therein, wherein at least two holes for deaeration are formed in the dented portion (see paragraph regarding claim 2 above).

5. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Belshé (5,934,473).

Belshé discloses a packaging system comprising:

a packaging carton (46); and

a single pad (12') formed of shock absorbing material;

wherein a hole (20) is formed so as to penetrate through a first surface of the single pad, which is brought into contact with an inner surface of the packaging carton when the single pad is placed in the packaging carton (Fig. 8), and

wherein the hole is also formed so as to penetrate through a second surface of the single pad on which a product to be packed is placed via a thin film member (39).

Belshé further discloses:

Regarding claim 2, an opening which is formed so as to penetrate through the first and second surfaces, and into which a deaerating-duct can be inserted (it is construed that the shock absorbing material has openings that are formed so as to penetrate through the first and second surfaces, and a deaerating-duct is certainly capable of being inserted into these openings. Furthermore, the functional recitations of

claim 2 only require that the apparatus is capable of performing the functioning as recited).

Regarding claim 3, grooves which are formed in at least one of the first and second surfaces – figure 7 shows grooves are formed on both side of the side walls (16 and 17), as sub-panels (17) folded on both side of side panel (16), a groove is formed between sub-panels (17), these grooves are clearly capable of providing communication between the openings.

Regarding claims 4 and 7, the holes (20) are formed on a side of a dented portion (the groove between sub-panels (17)) provided in the second surface, the dented portion for placement of the product.

Regarding claims 8 and 9, holes (20) are fully enclosed by the shock absorbing material (12') around the perimeter of the holes (Figs 2-3).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(e) as being a by Hull (7,128,208).

Hull discloses a packaging system comprising:

a packaging carton (10); and

a single pad (200) formed of shock absorbing material;

wherein a hole (220 or 255) is formed so as to penetrate through a first surface of the single pad, which is brought into contact with an inner surface of the packaging carton when the single pad is placed in the packaging carton (Fig. 6), and

wherein the hole is also formed so as to penetrate through a second surface of the single pad on which a product to be packed is placed via a thin film member (350).

Hull further discloses:

Regarding claim 2, an opening (220 or 255) which is formed so as to penetrate through the first and second surfaces, and into which a deaerating-duct can be inserted (it is construed that the shock absorbing material has openings that are formed so as to penetrate through the first and second surfaces, and a deaerating-duct is certainly capable of being inserted into these openings. Furthermore, the functional recitations of claim 2 only require that the apparatus is capable of performing the functioning as recited).

Regarding claim 3, groove which is formed in at least one of the first and second surfaces – figure 1 shows groove is formed on both side of the hole (220), the groove is clearly capable of providing communication between the openings.

Regarding claims 4 and 7, the holes (220) are formed on a side of a dented portion provided in the second surface, the dented portion for placement of the product (Fig. 6).

Regarding claims 8 and 9, holes (220 or 255) are fully enclosed by the shock absorbing material (200) around the perimeter of the holes (Fig 6).

Response to Arguments

8. Applicant's arguments filed December 5, 2007 have been fully considered but they are not persuasive.

9. In response to the Applicant's argument that: "... all of the alleged holes of Koike are merely indentions or spaces provided in either the first or second surface.", this is not found persuasive for the following reason:

The American Heritage Dictionary, defines a "hole" as follow:

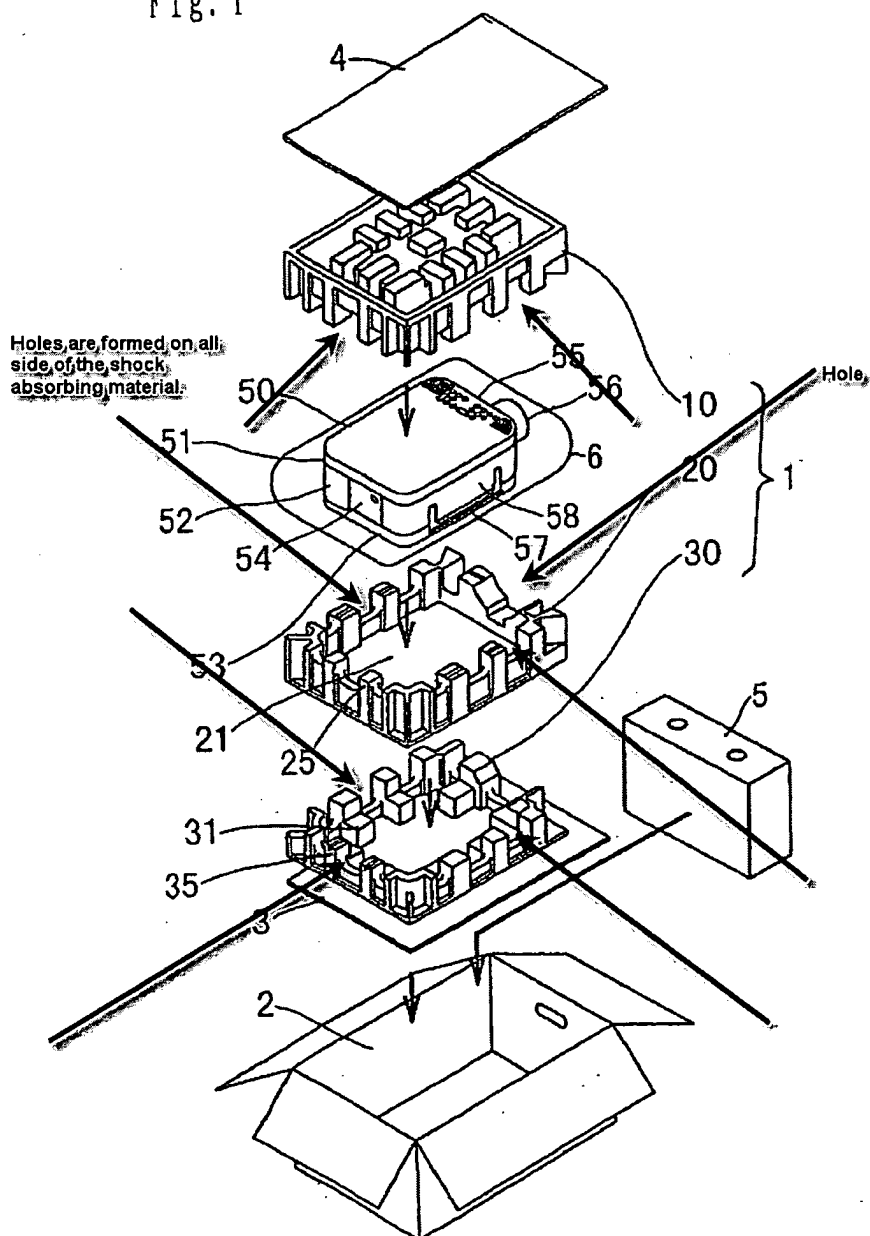
1. A hollowed place in something solid; a cavity or pit.
2. An opening or perforation.
3. A space in an otherwise solid mass
4. An opening, especially in a solid structure
5. An open space allowing passage

(The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2004, 2000 by Houghton Mifflin Company.)

Accordingly, the examiner maintains that figures 1-8 of Koike clearly show that holes are formed on all sides of the shock absorbing material. For example, figure 1 shows opening spaces between projections, on all sides, of each of shock absorbing materials (10, 20, 30).

Attached is the copy of Fig. 1 of Koike reference, and the arrows provided pointing to the openings (or holes) on all side of the shock absorbing materials (10, 20, 30), and each shock absorbing material is a single pad.

Fig. 1



Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

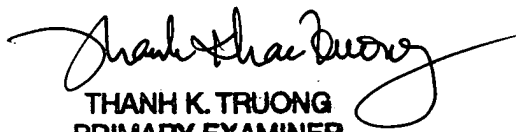
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tkf

January 10, 2008.


THANH K. TRUONG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700